

### **REMARKS**

Claims 1-15 and 17-23 are all the claims presently pending in the application. Claim 22 is amended to address the Office's 35 U.S.C. § 101 rejection. Claim 16 is canceled. No new matter is added.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claim 22 stands rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

Claims 1-15 and 17-23 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite.

With respect to the prior art, claims 1-3, 5-11, 13-15, 17, and 21-23 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Watanabe et al. (U.S. Patent Publication No. 2002/0031328 A1).

Claims 4, 12, and 18-20 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Watanabe in view of Cottrell (U.S. Patent Publication No. 2002/0005435 A1).

These rejections are respectfully traversed in the following discussion.

#### **I. THE 35 U.S.C. § 101 REJECTION**

With respect to claim 22, the Office alleges that "it is unclear if applicant intends to claim . . . signals, carrier waves and other forms of transmission media." (Office Action at page 2, paragraph 5).

While Applicant disagrees with this rejection, to expedite prosecution, claim 22 is amended to recite a "non-transitory computer-readable recording medium" to alleviate the Office's concerns and render this rejection moot. However, Applicant notes that "non-transitory" computer-readable recording media includes all computer-readable recording media, with the sole exception being a transitory, propagating signal.

Therefore, Applicant respectfully requests the Office to reconsider and withdraw this rejection.

## II. THE 35 U.S.C. § 112, SECOND PARAGRAPH REJECTION

### A. “receiving information . . . . . using the hybrid device”

At page 3, paragraphs 6(a)(i) and (ii) of the present Office Action, the Office alleges that [c]laim 1, line 5 recites “receiving information . . . . . using the hybrid device” (sic) it (sic) not clear what constitute (sic) receiving information using the hybrid device and where the information is received (i.e. receiving information in the hybrid device using the input unit of the hybrid device from a user? Receiving in the hybrid through some default setting or some other device?). . . . Claims 5, 14, 21, and 22 have (sic) similar deficiency (sic) as of claim 1 above.

However, Applicant respectfully disagrees and submits that the above-referenced recitation is clearly definite.

Contrary to the Office’s allegation, the Office’s rejection appears not to be based on the claims being indefinite. Instead, the Office’s rejection appears to be based on the claims not reciting additional limitations alone. However, MPEP § 2173.04 states that

[b]readth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

Specifically, it is not necessary to enumerate every type and location of received information using the hybrid device that would meet the claim recitations. If such a requirement existed in order to obtain the desired claims scope, Applicant would, in essence, be forced to construct the claim as a Markush group having every desired variant, and no such requirement exists in the MPEP, nor anywhere else under U.S. patent law.

Therefore, Applicant respectfully requests the Office to reconsider and withdraw this rejection.

**B. “application type”**

At page 3, paragraphs 6(a)(i) and (ii) of the present Office Action, the Office alleges that claim 1, “[l]ine 9 recites ‘application type’ (sic) it is unclear what constitutes the application type. . . . Claims 5, 14, 21, and 22 have (sic) similar deficiency (sic) as of claim 1 above.”

However, Applicant respectfully disagrees and submits that the above-referenced recitation is clearly definite.

MPEP § 2173.02 states, in part, that

[t]he essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

(A) The content of the particular application disclosure;

(B) The teachings of the prior art; and

(C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. . . .

The test for definiteness under 35 U.S.C. 112, second paragraph, is whether ‘those skilled in the art would understand what is claimed when the claim is read in light of the specification.’ *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986).

However, Applicant respectfully submits that the claims are indeed definite at least because the content of the application disclosure clearly provides support for “application type” at paragraphs [0034], [0036], and [0040] and Figures 2E, 4, and 5. Applicant respectfully reminds the Examiner that the claims are required to be interpreted in light of the specification.

Moreover, in view of the content of the particular application disclosure, one possessing the ordinary level of skill in the pertinent art at the time of the invention would clearly be able to provide a definite interpretation of the claims. Thus, the Office has clearly failed to assert or establish why the claimed feature is believed to be indefinite from the perspective of one of ordinary skill in the art. As such, the Office fails to make a *prima facie* rejection of the claims under the second paragraph of 35 U.S.C. § 112.

Therefore, Applicant respectfully requests the Office to reconsider and withdraw this rejection.

**C. “hybrid device capable of”**

At page 3, paragraphs 6(a)(i) and (ii) of the present Office Action, the Office alleges that “[l]ine 11 recites ‘hybrid device capable of’ which is indefinite as the device being capable of performing the function dose (sic) not define that the device will actually perform the functionality as described.”

However, Applicant respectfully disagrees and submits that the above-referenced recitation is clearly definite.

MPEP § 2173.05(g) states that

[t]here is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). . . . It was held that the limitation used to define a radical on a chemical compound as “incapable of forming a dye with said oxidizing developing agent” although functional, was perfectly acceptable because it set definite boundaries on the patent protection sought. *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971).

Similar to *in re Barr*, “the hybrid device [having] a capability of simultaneously performing a plurality of recording and/or reproducing functions by simultaneously recording data to and/or reproducing data from at least one information storage medium” sets definite boundaries on what patent protection is sought.

Specifically, it is not necessary to enumerate that a device would actually perform the functionality as described. If such a requirement existed in order to obtain the desired claims scope, Applicant would, in essence, be forced to construct the claim as a Markush group having every desired variant of functionality performance of which the hybrid device is capable, and no such requirement exists in the MPEP, nor anywhere else under U.S. patent law.

Therefore, Applicant respectfully requests the Office to reconsider and withdraw this rejection.

**D. Claim 23**

At page 3, paragraphs 6(a)(iii) of the present Office Action, the Office alleges that

[c]laim 23, line (sic) 1-2 recites “input unit is a front panel . . . . . or a remote control of (sic) he hybrid device” and further recited in line 3 (sic) “task handlers (sic) are not part of the hybrid device” (sic) it is unclear how the task-handlers are not part of the input unit if the input unit is the front panel of the hybrid device (a part of the

hybrid device) and as the hybrid device comprises task-handlers as recited in claim 1, line 2.

Firstly, nowhere does claim 23 recite, as alleged above, that “task handlers (sic) are not part of the hybrid device.” This is an error in recitation that is clearly made by the Office.

Further, the Office’s reasoning with respect to this rejection is clearly erroneous. Specifically, claim 1 recites “the hybrid device comprising a plurality of task-handlers corresponding to a common function key of an input unit, the task-handlers being controlled by operation of the common function key of the input unit . . . .” Claim 23 recites “wherein the input unit is a front panel of the hybrid device or a remote controller of the hybrid device; and the task-handlers are not part of the input unit.”

As is clearly shown through a reading of these recitations, the hybrid device of claim 23 includes a plurality of task-handlers and an input unit. However, the task-handlers are not part of the input unit. There is no disclosure from the claims or the specification that requires the task-handlers to be part of the input unit, even in view of the hybrid device including the task-handlers and the input unit.

Therefore, Applicant respectfully requests the Office to reconsider and withdraw this rejection.

### III. THE PRIOR ART REJECTIONS

#### A. The Watanabe Reference

Watanabe discloses a video recording/reproducing apparatus. (Watanabe at Abstract). The Office alleges that Watanabe anticipates the claims.

However, Applicant respectfully disagrees and submits that Watanabe fails to teach or suggest each and every limitation and element recited in the claims. As a result, this rejection is improper and unsupported by Watanabe, and, thus, should be withdrawn.

Specifically, MPEP § 2132 provides that “[a] claim is anticipates only if *each and every elements* as set forth in the claim is found, either expressly or inherently described, *in a single prior art reference*.” Verdegaal Bros. v. Union Oil Co. of CA, 814 F.2d 628, 631 (Fed. Cir. 1987).

With respect to independent claims 1, 5, 14, 21, and 22, the Office alleges that all elements and limitations are disclosed in Watanabe. However, Watanabe fails to teach or suggest several elements and limitations of these claims.

As a preliminary matter, the Office fails to provide any rationale whatsoever for the application of the cited paragraphs of Watanabe in rejecting the claims. It is to the Office's benefit to provide rationale so that Applicant understands how and why the claims are rejected. Unfortunately, the Office only provides citations to paragraphs without any reasoning, and forces Applicant to completely surmise as to the Office's rationale for applying the prior art references to reject the claims.

With respect to "changing the priorities of the task-handlers in the hybrid device, based on the received information" and "storing information regarding the changed priorities in the hybrid device, according to a predetermined application type indicating how the changed priorities are to be applied", as is recited in claims 1 and 22 and somewhat similarly in claims 5, 14, and 21, the Office alleges that these features are taught by paragraph [0086], lines 4-10 and paragraphs [0072] and [0090] of Watanabe. (Office Action at page 4, paragraph 8).

Specifically, paragraph [0086], lines 4-10 of Watanabe states that

[a] list 105 shown in FIG. 9 is a playback list selected from the list selection and the list shows the selection buttons of NEW sort 106, date sort 107, title sort 108, and classification sort 109. By selecting one of these buttons while moving a cursor, the corresponding sort is selected and performed according to the flow as shown in FIG. 10.

However, this portion of Watanabe completely fails to teach or suggest anything remotely related to "changing the priorities of the task-handlers in the hybrid device, based on the received information" or "storing information regarding the changed priorities in the hybrid device, according to a predetermined application type indicating how the changed priorities are to be applied".

The above-referenced portion of Watanabe simply teaches a sorting operation without anything resembling "priorities", "task-handlers", or "application type" being impacted by the sorting option of Watanabe. Indeed, Applicant respectfully requests the Office to particularly point out what portion and what language of the above-referenced paragraph teaches or suggests "changing the priorities of the task-handlers in the hybrid device, based on the received information"

or “storing information regarding the changed priorities in the hybrid device, according to a predetermined application type indicating how the changed priorities are to be applied”.

Paragraph [0072] of Watanabe states that

[t]he system controller 100 records the information relative to a program to be recorded (identifying signal) into a specified area of the recording medium 93, in accordance with recording a video signal (program) into the recording medium (hard disk) 93, and the recorded information on the program is reproduced and supplied to an OSD circuit (only screen display circuit) 96, as described later, not only for use in various displays, but, for example, the recorded information is displayed in a list, and used for rearrangement on the list based on the information, thereby displaying the program in the order of rearrangement.

However, the information being recorded in the above-referenced paragraph has nothing to do with “changing the priorities of the task-handlers in the hybrid device, based on the received information” or “storing information regarding the changed priorities in the hybrid device, according to a predetermined application type indicating how the changed priorities are to be applied”.

Specifically, if the Office had performed a cursory review of the paragraphs preceding paragraph [0072] of Watanabe, it would be clear that the information being discussed is clearly not related to “priorities”, “task-handlers”, or “application type, but is related to “information relative to a program to be recorded”. (emphasis added)

Again, in view of the above, Applicant respectfully requests the Office to particularly point out what portion and what language of the above-referenced paragraph teaches or suggests “changing the priorities of the task-handlers in the hybrid device, based on the received information” or “storing information regarding the changed priorities in the hybrid device, according to a predetermined application type indicating how the changed priorities are to be applied”.

Paragraph [0090] of Watanabe states that

[p]ressing the menu button 38 of the remote control 30 can show a window on a list display with buttons (not illustrated) for various reproducing methods on the tube face. These buttons include a sequential playback button, intro playback button, skip playback button, and shuffle playback button.

However, again, the above-referenced paragraph has nothing to do with “changing the priorities of the task-handlers in the hybrid device, based on the received information” or “storing information regarding the changed priorities in the hybrid device, according to a predetermined application type indicating how the changed priorities are to be applied”.

Specifically, there is no mention of “priorities,” “task-handlers,” or “application type” in the above-referenced paragraph. Further, there is nothing remotely resembling “priorities,” “task-handlers,” or “application type” in the above-referenced paragraph.

Again, in view of the above, Applicant respectfully requests the Office to particularly point out what portion and what language of the above-referenced paragraph teaches or suggests “changing the priorities of the task-handlers in the hybrid device, based on the received information” or “storing information regarding the changed priorities in the hybrid device, according to a predetermined application type indicating how the changed priorities are to be applied”.

Further, Applicant respectfully reminds the Office of the requirement to interpret the claims in light of the specification. Specifically, it seems as if the Office has largely based this rejection on an understanding of the language of the claims that is completely at odds with the support provided in the specification.

The above-referenced limitations are only a mere sampling of claim limitations that are falsely alleged by the Office to be taught or suggested by Watanabe. As a result, this rejection is improper and unsupported by Watanabe, and, thus, should be withdrawn.

Therefore, Applicant respectfully requests the Office to reconsider and withdraw this rejection.

## **B. The Cottrell Reference**

To make up for the above-referenced deficiencies of Watanabe, the Office applies Cottrell. Cottrell discloses an electronic device for regulating and controlling ambient parameters, such as ambient temperature. (Cottrell at Abstract). The Office alleges that the combination of Watanabe and Cottrell makes the claims obvious.

However, the Office fails to produce evidence and factually support that Cottrell makes up for any of the above-referenced deficiencies with respect to Watanabe. Further, Cottrell is directed to controlling heating and cooling in residential environments. Thus, Applicant respectfully submits that it would have been obvious to one having ordinary skill in the art that Cottrell is not analogous art.

In view of the above, even in spite of the attempt to modify Watanabe through the application of Cottrell, the Office fails to meet the initial burden of establishing obviousness. As a



result, a *prima facie* case of obviousness is not established. Thus, since the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness, the burden to establish patentability is not shifted to Applicant.

Therefore, Applicant respectfully requests the Office to reconsider and withdraw this rejection.

### III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-15 and 17-23, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Office is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Office find the application to be other than in condition for allowance, the Office is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

Respectfully Submitted,



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